

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-13, 15- 27, and 29 are pending in this application. Claims 14 and 28 were previously canceled without prejudice or disclaimer.

The outstanding Official Action includes a rejection of Claims 12 and 26 under 35 U.S.C. §103(a) as being unpatentable over Wada et al. (U.S. Patent No. 4,780,741, Wada) in view of what the outstanding Action continues to mistakenly characterize as “admitted prior art of record.”

The indication that Claims 13 and 27 are only objected to as depending from a rejected base claim and would be allowable if rewritten as indicated in the outstanding Action is gratefully acknowledged.

It is noted that the outstanding Action fails to indicate the status of Claims 1-11, 15-25, and 29 that were previously indicated to stand allowed. As no rejections or objections have been made directed to these claims and as these claims were previously indicated to stand allowed, it is presumed that Claims 1-11, 15-25, and 29 continue to be allowed.

Turning to the rejection of Claims 12 and 26 under 35 U.S.C. §103(a) as being unpatentable over Wada in view of what the outstanding Action continues to mistakenly characterize as “admitted prior art of record,” it is first noted that the outstanding Action has clearly misinterpreted the knowledge of what was known as conventional in Japan by the Japanese inventors to be an admission of prior art. In this regard, if the PTO intends to substitute a reference for this mistaken interpretation of knowledge in Japan being admitted “prior art,” it should do so because references cited as of interest fail to meet the requirement

noted at MPEP §7006.02(j) as to In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 N.3 (CCPA 1970) requiring all references relied upon in any capacity, even a minor one, to be positively included in the statement of the rejection.

Furthermore, it is noted that the top of page 3 of the outstanding Action indicates that Wada teaches “a thin layer forming device 7 configured to form the one-component developer being conveyed on the conveyor member into a thin uniform layer having a height corresponding to 1 to 1.5 times the diameter of the toner particles of the one-component developer.” This same portion of page 3 of the outstanding Action then states that “[t]he development region includes a gap between the conveyor surface portion and the opposed photoconductive surface portion that is equal to or less than about 150 micron.” Missing from these assertions, however, is the location in Wada that such teachings appear.

This failure to indicate these teaching locations is a violation of precedent (see In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”) and 37 CFR § 1.104(c)(2) that requires that when a reference shows inventions other than the claimed one, the particular parts of that reference being relied upon “must be designated as nearly as practicable.”

Moreover, the prior art blade 104 teaching at col. 2, lines 7-11 relate to the gap between blade 104 and carrier 101 being 1.5 times as thick as the thickness of the toner layer to be formed. This teaching of 1.5 relates to a gap spacing of the blade 104 and a final layer thickness and does not teach that a thin uniform layer having a height corresponding to 1 to 1.5 times the diameter of the toner particles of the one-component developer.

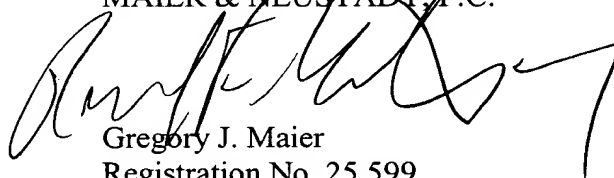
Appln. No. 09/535,158
Reply to Office Action of 06/06/03

Furthermore, no mention can be found anywhere in Wada as to any spacing between the conveyor surface portion and the opposed photoconductive surface portion, much less that a spacing "that is equal to or less than about 150 micro." is to be used as the Action alleges.

Accordingly, the rejection of Claims 12 and 26 under 35 U.S.C. §103 is improper as lacking any "prior art" evidence of obviousness to establish the required *prima facie* case of obviousness and withdrawal of this improper rejection is believed to be in order.

As it is believe that no other issues remain outstanding in this application, it is believed that this application is in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Raymond F. Cardillo, Jr.
Registration No. 40,440



22850

(703) 413-3000
Fax #: (703) 413-2220
GJM:RFC/jmp